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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,260	12/21/2001	Robert J. Price	8350.1156-00	5013

7590 11/09/2004

Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
1300 I Street, N.W.
Washington, DC 20005-3315

EXAMINER

LOPEZ, FRANK D

ART UNIT	PAPER NUMBER
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3745

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/024,260

Applicant(s)

PRICE, ROBERT J.

Examiner

F. Daniel Lopez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 2, 2004 has been entered.

Response to Amendment

Applicant's arguments filed August 2, 2004, have been fully considered but they are not deemed to be persuasive.

Applicant's arguments with respect to claims 1-22 have been considered but are deemed to be moot in view of the new grounds of rejection. The new grounds of rejection are necessitated by the added limitation concerning the valve opening decreasing as the pump speed decreases.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

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one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation "to reduce an opening of the valve in response to a reduction in the speed of the pump" has been added to all the independent claims (claim 1 line 7-8, claim 10 10-11 and claim 22 line 11-12); but is not supported by the original disclosure. The disclosure states "The method includes generating a signal representative of a speed of the pump and selecting a relationship from a plurality of relationships between valve commands and an operator input. The selection is based upon the speed signal. A valve is modulated...based on the selected relationship and the operators input." (page line **paragraph 9**).

The question is when is the relationship selected and how long does this selection last? Is the relationship selected only when the operator command changes from a neutral position to a non-neutral position or constantly, no matter what the operator command is, or is there another alternative? Since applicant has not stated when the relationship is to be changed, this limitation is not supported by the original specification and is therefore, new matter.

One of ordinary skill in the loader or excavator art would recognize that an operator operating a control valve to move an actuator would want the actuator to move smoothly. Having the control valve jump from one opening to another opening (by jumping from one relationship to another), would appear to cause the actuator to not move smoothly. Therefore, one of ordinary skill in this art would expect this disclosure to not support this limitation. One of ordinary skill in the loader or excavator art, reading this disclosure would expect that the operator would set the speed of the pump, corresponding to a particular mode, and work in this mode until ready to change to another mode. When the operator is ready to change to another mode, the operator command would be returned to neutral (so that the actuator does not unexpectedly speed up or slow down), set the new pump speed, corresponding to a new mode, and work in the new mode. Therefore, nothing in the specification remotely suggests support for the above limitation.

Claim Rejections - 35 USC § 102

Claims 1, 2, 5, 7-14, and 16-22, inasmuch as they are supported by the specification, are rejected under 35 U.S.C. § 102(b) as being anticipated by Devier et al. Note that the rotational speed of the pump () is used to generate the actual pump flow (Q) and the actual pump flow (Q) is compared to the requested pump flow to determine the relationship between the valve command and the operator input (discussed e.g. column 5 line 1-68).

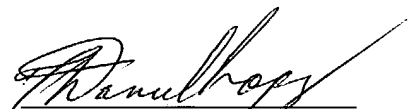
Claims 1-4, 6-15, 17-19 and 22, inasmuch as they are supported by the specification, are rejected under 35 U.S.C. § 102(f) as being anticipated by Cobo et al (6,305,162). It would appear that the sole inventor of the instant application is not the inventor of the subject matter of the above claims; since the sole inventor of the instant application is not listed as one of the inventors of Cobo et al, even though both are owned by Caterpillar; and the limitations of the above claims are disclosed in Cabo et al.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Lopez whose telephone number is (703) 308-0008. The examiner can normally be reached on Monday-Thursday from 6:30 AM -4:00 PM. The examiner can also be reached on alternate Fridays.

I will be moving to the new PTO campus in November. When I move, my new telephone number will be 571-272-4821.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Look, can be reached on (703) 308-1044. The fax number for this group is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0861.



F. Daniel Lopez
Primary Examiner
Art Unit 3745
November 05, 2004